

## **AMENDMENT AND RESPONSE**

Applicant: Tyler E. PEASE

Serial No.: 09/649,692

Examiner: Y. Horton

Art Unit: 3635

Atty. Dkt.: W1009.10-US-01 [Formerly 141.009/A]

### **REMARKS**

By this Amendment Claims 11, 21, 23, 25, 28, 29, 31 and 33 are amended. No new claims have been added. Therefore, Claims 1-33 are pending. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Applicant expresses appreciation for the Examiner's indication of allowed Claims 3-6, 10, 13, and 16-20. In addition, Applicant expresses appreciation for the Examiner's acceptance of the drawings. In the current Office Action, the Examiner failed to mention the disposition of Claim 9. Applicant had previously amended Claim 9 to be in independent form, including all the limitations of the claims from which it depended. The Examiner had indicated Claim 9 would be allowable if this amendment was made. Applicant requests that Claim 9 be allowed.

The Examiner indicated an objection to Claim 23, and that Claim 23 would be allowable if rewritten in independent form. Claim 23 has been rewritten in independent form, including all the limitations of the base claim and intervening claims. Claim 23 is now in condition for allowance. In addition, Claim 24 is allowable by virtue of being dependent upon an allowable base claim.

By this amendment, Claim 11 is amended for clarification purposes. Claims 21, 25, 28, 29, 31 and 33 were amended to make them dependent upon allowable claims. The amended claims are all supported by the specification. No new matter has been added.

### **Claim Rejections**

#### **Double Patenting**

A response was not filed in response to the outstanding Office Action in U.S. Patent Application Serial No. 09/704,137 such that as of February 6, 2003, this

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application has gone abandoned and is no longer pending. Due to the abandonment of U.S. Patent Application Serial No. 09/704,137, Applicant respectfully requests withdrawal of the provisional rejection based upon nonstatutory double patenting.

35 U.S.C. § 102(b)

The Examiner has rejected Claims 1, 2, 21, 22, 24, 25 and 27 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,638,651 to FORD.

Regarding Claim 1, FORD does not teach nor suggest a foam sheet having first and second opposing edges generally parallel to the first and second grooves and first and second reinforcing strips disposed inwardly away from the first and second edges.

Claim 21 has been amended to be dependent upon allowed Claim 3 and Claim 22 is dependent upon allowable Claim 21. Claim 24 has been amended to be dependent upon allowable Claim 23. Claim 25 has been amended to be dependent upon allowed Claim 3, and Claim 27 is dependent upon allowable Claim 25. Therefore, withdrawal of the §102(b) rejection of Claims 1, 2, 22, 24, 25, and 27 is respectfully requested.

The Examiner has rejected Claims 1 and 30-33 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,408,594 to PORTER. The Applicant respectfully traverses the Examiner's rejection of the claims.

Regarding Claim 1, PORTER does not teach or suggest the use of grooves to receive the reinforcing strips. Therefore, Porter does not teach or suggest all the claim limitations of Claim 1. As a result, PORTER may not be properly asserted as a §102(b) prior art reference.

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Regarding Claims 30-33, Claim 30 is dependent upon allowable Claim 29. Claims 31 and 33 have been amended to be dependent upon allowed Claim 3, and Claim 32 is dependent upon Claim 31.

35 U.S.C. § 103(a)

### PORTER

The Examiner has rejected Claims 1 and 28-33 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,408,594 to PORTER. Although the Examiner indicated the rejection was under § 102(b), it is the Applicant's contention that this was an error, and meant to be § 103(a). The Applicant respectfully traverses the rejection of these claims.

Regarding Claim 1, PORTER does not disclose the use of grooves to receive the reinforcing strips. The Applicant traverses the Examiner's contention that grooves are well known in the art for the purpose set forth in the Application, and the Examiner has not provided a reference to that effect. Furthermore, Applicant traverses the Examiner's assertion that there is no criticality for the spacing of the reinforcing strips. The spacing of the reinforcing strips disclosed within the application provides for a "continuous expanse of equidistantly spaced reinforcing strips on two foot centers" (Application pg. 7 lines 5-13), or another predetermined equidistant spacing depending upon dimensions of the panel and number of reinforcing strips.

Claims 28 and 29 have been amended to be dependent upon allowed Claim 3. Claim 30 is dependent upon allowable Claim 29. Claims 31 and 33 have been amended to be dependent upon allowed Claim 3, and Claim 32 is dependent upon Claim 31.

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FORD

The Examiner has rejected Claims 6-8, 11, 12, 14, 15 and 26 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,638,651 to FORD. Applicant respectfully traverses the rejection of the claims.

Regarding Claims 6-8, the Examiner has indicated that Claim 6 was both allowable and rejected under 35 U.S.C. 103(a). Since Applicant's previous Amendment made Claim 6 dependent upon allowable claims, it is the Applicant's assertion that Claim 6 is in condition for allowance. Since Claim 6 is allowable, Claims 7 and 8, which are dependent therefrom, are also allowable.

Regarding amended Claim 11, FORD does not teach nor suggest the reinforcing layer having a mechanically textured surface or the surface of the reinforcing strips having a plurality of spaced apart holes, a plurality of spaced apart slots, or a combination thereof configured to engage mechanical fasteners. It is Applicant's contention that amended Claim 11 is in condition for allowance. Claims 12, 14 and 15 are dependent upon Claim 11 and should be allowed as well.

Further with regard to Claims 14 and 15, Applicant respectfully traverses the Examiner's assertion that FORD may be properly used as a 103(a) obviousness reference. All the claim limitations of the claimed invention must be taught or suggested by the prior art in order to establish prima facie obviousness. Furthermore, the prior art can be modified to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In the outstanding Office Action, the Examiner has admitted that FORD does not disclose the steps of applying adhesive and rolling the reinforcing layers. Applicant's disclosure teaches that the "reinforcing layers or sheets are preferably made of plastic, paper, foil...preferably in a composite film form" (Application page 7, lines 18-20). FORD teaches the inside and outside skins (12, 14) being oriented strand board of

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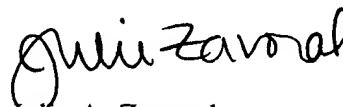
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3/8 to 1 inch thickness (col. 3 ln. 41-44). It is well known in the art, that oriented strand board of this thickness is unable to be manufactured in rolls and applied in the manner disclosed in the present application. The limitations are not suggested nor is there a reasonable expectation of success. The application of adhesive and rolling of reinforcing layers limitations of Claim 14 are not taught and the Examiner has failed to show where the admittedly absent limitations are suggested within the cited FORD reference. Claim 26 is dependent upon Claim 25, which has been amended and is in condition for allowance. Applicant asserts Claim 14 is now in condition for allowance, as well as Claim 15, which is dependent therefrom.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be due, or to credit any overpayment made, to Deposit Account No. 50-2522.

Respectfully submitted,



Julie A. Zavoral  
Attorney For Applicant  
Reg. No. 43,304

Customer No. 35110  
Patterson, Thunte, Skaar & Christensen, LLC  
2000 U.S. Bank Center  
777 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202  
Phone: (414) 276-0977  
Direct: (414) 277-6722  
Fax: (414) 276-0982

*Please grant an extension of time necessary for entry; charge any fee due to Deposit Account No. 50-2522.*

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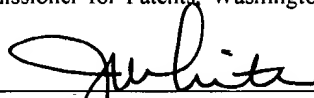


**CERTIFICATE OF MAILING**

I hereby certify that this document is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on ~~2~~

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5 February 2003

  
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Judith A. White

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## VERSION WITH MARKINGS SHOWN

Wherein deleted material is shown in **[bracketed]** form and added/amended material is shown in **underlined** form as follows:

11. **(Twice Amended)** A method of manufacturing an insulated wall panel, comprising the steps of:

creating a rigid foam block having first and second opposing sides;

cutting the foam block to form a plurality of stacked individual foam sheets having first and second sides and a plurality of parallel recesses in the first side;

inserting a reinforcing strip having a top and a bottom into each of the plurality of recesses in each of the plurality of sheets, wherein the reinforcing strip has a surface finish including at least a mechanically textured top surface [.] **and** a plurality of spaced apart holes [or], a plurality of spaced apart slots, **or a combination thereof,** configured to engage mechanical fasteners; *(24)* *new matter.*

covering the tops of each of the reinforcing strips with a first thin reinforcing layer; and

bonding the first reinforcing layer to the first side of each of the foam sheet.

*Allow*  
21. **(Amended)** The insulated wall panel of Claim [1] 3, wherein the first and second reinforcing strips include a central recessed portion configured to receive and support the head of a fastener.

*Allow*  
23. **(Amended)** [The insulated wall panel of Claim 21, wherein the first and second reinforcing strips include] An insulated wall panel, comprising:  
a rigid foam sheet with first and second planar sides and having first and second grooves extending substantially the full length of the sheet in a

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substantially parallel orientation in the first side of the sheet and first and second opposing edges generally parallel to the first and second grooves;

a first reinforcing strip having a length, a top and a bottom with the bottom being disposed in the first groove and the top facing outwardly away from the first groove, wherein the first strip extends substantially the full length of the sheet and disposed in said sheet inwardly away from the first and second edges of the sheet;

a second reinforcing strip having a length, a top and a bottom with the bottom being disposed in the second groove and the top facing outwardly away from the second groove, wherein the second strip extends substantially the full length of the sheet and is disposed in said sheet inwardly away from the first and second edges of the sheet;

a first thin reinforcing layer bonded to the first planar side of the sheet, and extending across the top of the first and second grooves and substantially covering the entire first planar side of the sheet; and

a second thin reinforcing layer bonded to the second planar side of the sheet and extending across substantially an entire surface of second planar side,

wherein the first and second reinforcing strips include a central recessed portion configured to receive and support the head of a fastener and two non recessed portions that flank the recessed portion and extending substantially the entire length of the respective first and second reinforcing strips.

25. **(Amended)** The insulated wall panel of Claim [1] 3, wherein an outwardly facing surface of the first and second reinforcing strips is configured to guide the insertion of a fastener therethrough.

28. **(Amended)** The insulated wall panel of Claim [1] 3, wherein the rigid foam sheet has a second side opposite the first side that has no reinforcing strips.



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29. **(Amended)** The insulated wall panel of Claim [1] 3, wherein lateral sides of the first and second reinforcing strips are spaced at least 6 inches away from the lateral edges of the rigid foam sheet. no reinforcing strips.

31. **(Amended)** The insulated wall panel of Claim [1] 3, wherein lateral sides of the first and second reinforcing strips are spaced at least 8 inches away from the lateral edges of the rigid foam sheet.

33. **(Amended)** The insulated wall panel of Claim [1] 3, wherein the first and second reinforcing layers primarily consist of paper, foil or plastic film.